APPENDIX A

DECISION BY THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF VIRGINIA ALEXANDRIA DIVISION

November 14, 1975

"THE COURT: . . . I don't think I have jurisdiction; I think it's improperly filed. I'll dismiss it for that reason."

UNITED STATES COURT OF APPEALS
FOR THE FOURTH CIRCUIT

73-1699

MARY HELEN SEARS,
Appellant,

vs.

ROBERT GOTTSCHALK, Commissioner of Patents,
Appellees.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF VIRGINIA, AT ALEXANDRIA.

Upon consideration of the plaintiff's motion to permit the district court to consider a motion pursuant to rule 60(b)(6), by counsel,

IT IS ORDERED that the motion is denied.

For the Court—by Direction

/s/ WILLIAM K. SLATE, II
Clerk

Filed: December 15, 1975

[SEAL]

EXHIBIT A

LEE PHARMACEUTICALS
1444 Santa Anita Ave., P.O. Box 3836
South El Monte, Calif. 91733
(213) 442-3141

September 9, 1975
HL 75-441

Mr. Joseph Nakamura
Solicitor, United States Patent Office
Washington, D.C. 20230

Dear Mr. Nakamura:

I am writing you as President of Lee Pharmaceuticals and a named inventor on many of its patents and patent applications, to express my dismay that abandoned patent applications in the Patent Office files are not publicly available to be searched before a patent application is filed and are not used in examining patent applications after they are filed. This is particularly difficult for me to rationalize with what I understand to be the fact that such abandoned applications *are* considered by the courts as evidence that may invalidate an issued patent. In this connection, I have noted the recent use of non-public evidence to invalidate patents in *Del Mar Engineering Laboratories* vs *United States* 186 USPQ 42 (Ct. Cls. 1975) and in *Becton, Dickinson & Co.* vs *Sherwood Medical Industries, Inc.*, No. 72-3599 decided by the Fifth Circuit Court of Appeals July 28, 1975.

At present, my company has a unique commercial product constituting a carvable dental composite restorative material covered by Application Serial No. 504,838. I am writing this letter to request that the Patent Office search for and make available to my company under 5 U.S.C. 552(a)(3) those abandoned patent applications that *may* be in any way germane, based on their subject

matter, to the patentability under any section of the patent statutes of the claims of Application Serial No. 504,838—and that those claims be evaluated relative to all abandoned patent applications so located.

I look forward to your prompt response.

Very truly yours,

/s/ Henry Lee
HENRY LEE, Ph.D.
President

HL:lm

EXHIBIT B

[SEAL]

U.S. DEPARTMENT OF COMMERCE
PATENT OFFICE

Address Only: COMMISSIONER OF PATENTS
Washington, D.C. 20231

September 30, 1975

Dr. Henry Lee
President, Lee Pharmaceuticals
1444 Santa Anita Avenue
P.O. Box 3836
South El Monte, Calif. 91733

Dear Mr. Lee:

This is in response to your letter of September 9, 1975, received on September 16, 1975, requesting that the Patent and Trademark Office search for and make available to your company under 5 USC 552(a)(3), those abandoned applications that may be germane to the patentability of claims in application Serial No. 504,838.

I regret that your request must be denied. There are literally hundreds of thousands of abandoned patent applications in the Patent and Trademark Office. An unreasonable amount of effort would be involved in locating any which might be germane to the patentability of claims in application Serial No. 504,838. And even if any were located, we would be prohibited by statute, 35 USC 122, from making them available to your company. The noted statute specifies that "[a]pplications for patents shall be kept in confidence by the Patent Office * * *." 35 USC 122. Abandoned applications, accordingly, are exempt from disclosure. 5 USC 552(b)(3).

You also request an evaluation of the claims in application Serial No. 504,838, relative to all abandoned patent

applications located. This request is likewise denied since 5 USC 552(a)(3) applies only to existing records and does not require an agency to create a record.

Should you desire to do so, you may submit a written appeal from this decision within 30 calendar days after the date of this letter. The appeal shall include a copy of your original request, a copy of this letter and a statement of the reasons why you believe this denial is in error. The appeal should be addressed to The Commissioner of Patents and Trademarks, Freedom of Information Request Control Desk, Box 50, Washington, D.C. 20231.

Sincerely,

/s/ Joseph F. Nakamura
JOSEPH F. NAKAMURA
Solicitor

cc: Asst. Gen. Counsel for Admin.

EXHIBIT C

[SEAL]

LEE PHARMACEUTIALS

1444 Santa Anita Ave., P.O. Box 3836
South El Monte, California 91733 U.S.A.
Tel. (212) 442-341 WATS: (800) 423-4173
TWX: (910) 587-3420

October 29, 1975

Mr. Joseph Nakamura
Solicitor, United States Patent Office
Washington, D.C. 20230

Dear Mr. Nakamura:

This a written appeal from the decision which appears in the September 30, 1975 letter signed by Joseph F. Nakamura, Solicitor. A copy of my original request dated September 16, 1975 and of Mr. Nakamura's September 30, 1975 letter are enclosed.

The reasons why I believe Mr. Nakamura's denial of my request is in error include the following:

1. As my original request points out non-public evidence, including abandoned patent applications, are considered by the courts as evidence that may invalidate patents for failure to measure up to the constitutional patentability standard as embodied, for example, in 35 U.S.C. 103. Mr. Nakamura does not suggest otherwise.

2. 35 U.S.C. 6 provides that the Commissioner . . . shall superintend or perform all duties required by law respecting the granting and issuing of patents".

As a part of his duties the Commissioner is required to "cause an examination to be made" of each application for patents and of "the alleged new

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invention" contained therein and to issue a patent on such applications only "if on such examination it appears that the applicant is entitled to a patent under the law" 35 U.S.C. 131.

3. To determine whether the "applicant is entitled to a patent under the law" it is necessary for the Commissioner to consider the evidence germane to that issue which is contained in abandoned patent applications.

My request that the Commissioner discharge that duty as to my company's application 504,838—a duty which is imposed by the patent statutes—is not rationally denied by Mr. Nakamura's observation that "5 U.S.C. 552(a)(3) . . . does not require an agency to create a record".*

4. Since, as demonstrated by paragraphs 2 and 3, availability and consideration of abandoned applications is "necessary to carry out the provisions of "an Act of Congress" such records are excluded from the confidence provisions of § 122—and are expressly subject to the *non discretionary* disclosure portions of that statute.

5. Mr. Nakamura's conclusion that under 35 U.S.C. 122 and 5 U.S.C. (b)(3) abandoned applications are "exempt from disclosure" conflicts squarely with *Administrator, F.A.A.* v. *Butterfield* 422 U.S. 255, 45 L.Ed. 2d 165 (1975).

As explained in that decision, "all parts of an act . . . are to be given effect" and "repeals by implication" are not favored. Statutes capable of coexistence are to be construed to give effect to both

* Notably my request was that abandoned applications which are "germane" be considered in connection with my application Serial No. 504,838—just as all other germane references are considered.

or all. Both the FOIA and § 122 have disclosure and nondisclosure aspects. Both aspects of both acts can and should be given effect.

The disclosure aspect of § 122 is concerned with those applications "necessary to carry out the provisions of any Act of Congress". The applications in this category are expressly excluded from its "confidence provisions" by § 122's own terms. "The wisdom of the balance struck by Congress is not open to judicial scrutiny." Robertson, supra, 45 L. Ed. 2d at 174.

Very truly yours,

/s/ Henry Lee
HENRY LEE, Ph.D.
President

HL/rcw
enclosures

EXHIBIT D

[SEAL]

UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Address Only: COMMISSIONER OF PATENTS AND
TRADEMARKS
Washington, D.C. 20231

December 1, 1975

Dr. Henry Lee
President, Lee Pharmaceuticals
1444 Santa Anita Avenue
P.O. Box 3836
South El Monte, California 91733

Re: Appeal from initial decision
denying a request under the
Freedom of Information Act

Dear Dr. Lee:

This is in response to your letter of October 29, 1975, appealing from the denial of your request to have the Patent and Trademark Office search for and make available to your company under the Freedom of Information Act, 5 USC 552, those abandoned patent applications that may in any way be germane to patentability of the claims in your pending patent application. You had also requested, and been denied, an evaluation of the claims in the light of all abandoned applications so located.

I have reviewed the reasons why you believe the denial of your request was in error but am not convinced that the denial was wrong.

Congress has directed that "[a]pplications for patent shall be kept in confidence by the Patent [and Trade-

mark] Office and no information concerning the same given without authority of the applicant or owner * * *." 35 USC 122. The U.S. District Court for the Eastern District of Virginia has held in *Sears* v. *Gottschalk*, 357 F. Supp. 1327, that abandoned patent applications are barred from disclosure by 35 USC 122, and therefore specifically exempted by statute from disclosure under the Freedom of Information Act, as provided in 5 USC 552(b)(3). The Court's decision was affirmed by the U.S. Court of Appeals for the Fourth Circuit (502 F.2d 122). Certiorari was denied by the Supreme Court on June 30 of this year (*sub nom Sears* v. *Dann*) and rehearing was denied on October 6.

I cannot agree with your contention that my duty to "cause an examination to be made" of patent applications (35 USC 131) requires me to consider abandoned patent applications as references . The same contention was made, and rejected by the Court, in *Sears* v. *Gottschalk, supra.*

The two cases cited in your original request (*Del Mar Engineering Laboratories* v. *United States*, 186 USPQ 42 (Ct. Cls. 1975), and *Becton, Dickinson* v. *Sherwood*, 187 USPQ 200 (5th Cir. 1975)) did not involve the use of abandoned patent applications as references.

I cannot agree with your view that the exemption of abandoned applications from disclosure conflicts with the Supreme Court's decision in *Administrator, FAA* v. *Robertson*, 422 U.S. 255, 95 S. Ct. 2140. The same contention was recently made by the plaintiff in the *Sears* case and rejected by the Court in denying the plaintiff's motion under Rule 60(b), FRCP, for relief from judgment (E.D. Va., November 14, 1975).

Finally, your request that an evaluation of the claims in your pending application be made is a request to have a record (evaluation) made. The Freedom of In-

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formation Act does not require agencies to create a record, and your request was, therefore, properly denied.

I am, therefore, finally denying your Freedom of Information Act request on the ground that the requested records fall within the (b)(3) exemption of the Act and the requested evaluation is not within the scope of the Act. This is a final decision for the Department of Commerce from which you have a right of judicial review as specified in 5 USC 552(a)(4)(B).

Sincerely,

/s/ C. Marshall Dann
C. MARSHALL DANN
Commissioner of Patents and Trademarks

cc: Special Asst. to the Secretary
for Public Affairs
Asst. Secretary for Administration
Asst. General Counsel for Administration